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In re Application of: :  
FRAZZITTA, BARTHOLOMEW J., et al. : DECISION ON PETITION  
Application Serial No.: 08/889,033 :  
Filed: July 7, 1997 :  
For: **TRANSACTION SYSTEM** :

This decision is in response to the three petitions filed March 11, 2010. The first petition is pursuant to 37 CFR § 1.144 to withdraw the restriction requirement set forth in the January 13, 2010 Office action. The second petition is urged against reintroduction of a rejection reversed by the Board of Patent Appeals and Interferences (BPAI). The third petition is to have the application treated as "special and to have the application transferred to another examiner. The Technology Center Director has authority to decide these petitions as set forth in MPEP § 1002.02(c).

BACKGROUND

This application was filed July 7, 1997. On October 6, 1999 a first Office action was mailed. In response thereto, applicant filed an amendment On January 6, 2000. A second non-final action was mailed on March 7, 2000. On May 11, 2000 applicant responded to the second non-final.

Subsequently, on July 17, 2000 a final Office action was mailed. On August 4, 2000 applicant filed a letter requesting withdraw of premature final rejection.

On October 5, 2000 Appellant filed a Notice of Appeal. On January 8, 2001 an Appeal Brief was filed. On May 7, 2001, prosecution was reopened and a final Office action mailed.

On May 21, 2001, a petition was filed that an Examiner's Answer contained an impermissible new grounds of rejection. On July 6, 2001 a Reply Brief was filed. On July 26, 2001 prosecution was again reopened by the mailing of a non-final Office action. On October 5, 2001 a supplemental Appeal Brief was filed.

On June 28, 2002, the application was held abandoned for failure to timely file a proper reply to the Office action of July 26, 2001. Petitioner filed a petition to withdraw holding of abandonment on July 16, 2002. On March 30, 2002 the petition was granted by the Technology Center Director.

On July 16, 2003 an Examiner's Answer was mailed. In response thereto, a Reply Brief was filed on August 27, 2003. On July 21, 2005 the BPAI reversed the examiner's rejections and remanded the application to consider relevant prior art. As a result of the remand, prosecution was again reopened by mailing of a non-final Office action on October 27, 2005.

A Notice of Appeal was filed on January 26, 2006. Subsequently, a third Brief was filed by Appellants. An Answer was mailed on June 30, 2006 and Reply Brief filed on August 17, 2006. On September 21, 2007 the BPAI affirmed the examiner in-part and entered a new grounds of rejection. On November 15, Appellants filed a request for rehearing of the Boards decision. On April 15, 2008 the BPAI denied making any modifications in their decision.

On April 14, 2008, Appellant petitioned the actions of the BPAI. On April 15, 2008 an amendment was filed pursuant to 37 CFR § 41.50(b)(1). On May 7, 2008, the Chief Administrative Patent Judge denied the petition of April 14, 2008.

On June 12, 2008 an Advisory action was mailed denying entry of the April 15, 2008 amendment. On June 10, 2008 an amendment was filed in accordance with the requirement set forth in the Advisory action of June 12, 2008.

On June 19, 2009 prosecution was once again reopened with approval of the Technology Center's Director. On July 7, 2009 a supplemental Office action was mailed. On September 21, 2009 applicant filed a response and a declaration under 37 CFR § 1.132. The response added new claims 48-54. On January 13, 2010, a final Office action was mailed. In the Office action the examiner held that claims 50-54 are drawn to a non-elected invention. Since the originally presented claims had received an action on the merits, the original claims are constructively elected by original presentation.

On March 11, 2010, applicant filed a response. The three instant petitions were filed on even date therewith.

The petitions will be treated in the order set forth above.

#### Petition Pursuant to 37 CFR § 1.144

Petition under this ground are considered timely if filed after the requirement for election/restriction is made final by the examiner. However, a petition will not be considered if reconsideration of the requirement was not requested. See §1.181. Therefore, the petition pursuant to 37 CFR § 1.144 will be treated as a request for reconsideration.

### OPINION

Petitioner contends that the Office has not shown the alleged groups to be distinct. "The Action has not provided the required showing of distinct inventions. The action doesn't even state the relationship criteria being relied upon to allege that the Groups are distinct, e.g. unrelated inventions, combination/subcombination, separately usable subcombinations, etc."

In reviewing the requirement as set forth in the January 13, 2010 Office action, the examiner merely repeats claim limitations found in claims 50-54 and concludes that the new "invention" is distinct because the limitations have "not been claimed before". This is not adequate grounds for establishing a basis for distinctness. The question of "serious burden" will not be addressed. It is a moot point in that the examiner first failed to establish grounds for distinct inventions. Consequently, **The restriction requirement is withdrawn.**

#### Petition Against Reintroduction of a Rejection Reversed by the BPAI

Petitioner contends that the 35 USC § 103(a) rejection of claims 19 and 40 be withdrawn. Petitioner states: "The record shows that the current 35 U.S.C. § 103(a) rejection of claims 19 and 40 based on McClure and Granzow is identical to a previously appealed rejection. That is, the 35 U.S.C. § 103(a) rejection of claims 19 and 40 based on McClure and Granzow was already fully considered by the BPAI in Appeal No. 2007-0599. In their decision dated September 21, 2007, the BPAI reversed said rejection of claims 19 and 40. Thus, the Office is legally barred from again asserting these same rejections based on principles of res judicata. The Examiner is also committing prejudicial error."

### OPINION

A careful review of the record indicates that, in fact the rejection of claims 19 and 40 under 35 USC 103 based on the McClure and Granzow references was previous reversed by the BPAI in the decision of September 21, 2007. Consequently, the rejection of claims 19 and 40 is withdrawn as it pertains to 35 USC § 103 based upon McClure and Granzow. The petition to withdraw the rejection of claims 19 and 40 is **GRANTED**.

#### Petition to Have the Application Treated as "Special" and Petition to Have the Application Transferred.

##### a.) Petition to Have Application Treated as "Special"

Petitioner argues that the instant application should be granted special status. Petitioner urges that "(t)he facts of record show that this application has been pending more than twelve(12) years. According to MPEP § 708.01 (listed reason 'I') and § 707.02, an application pending more than five years is to be treated as a "special" case and be advanced out of turn by the Office. That is, this application was to have been given a

very high priority by the Examiner in the order of examination (MPEP § 708), and its priority handling was to have been personally overseen by the supervisory patent examiner (SPE) (MPEP § 707.02). The application was to have been given high priority in the Examiner's case docket so it could be treated by the Examiner in a quicker manner (e.g., similar to a timely treatment of an amendment after final rejection). Because of the facts of record, this application is entitled to such "special" status without any fee."

#### OPINION

Petitioner is correct in that the pendency of the application is in excess of five years and therefore must be considered "special". However, a petition to effect such a status is unnecessary as the MPEP clearly indicates that an application pending for such a period is special in nature. Accordingly, the request to afford special status is **DISMISSED**. The application is special as defined in MPEP §§ 707.02 and 708.01(I).

#### b.) Petition to Have the Application Transferred

Petitioner requests that the application be transferred to a new and objective primary examiner. Petitioner states "as factually evidenced by the prosecution history, the Examiner's propensity to continuously prosecute this application for more than twelve years has not been in conformance with the Office's normal and expected examining procedures, especially with regard to "compact prosecution". Also, the Examiner's inability to efficiently examine this application has unduly harmed the Applicants with respect to patent term extension (as discussed above). The obfuscation and delay caused by the Examiner indicates a pattern of arbitrary and capricious action, and evidence of willful or wanton misconduct (and bias), against Applicants.

Applicants have the belief that the Office has at least one primary examiner who is capable of completing examination of an application in less than twelve years. If this is true, then Applicants petition to have their application transferred to that primary examiner."

#### OPINION

Upon filing, an application is assigned to an examiner based upon technology and expertise in a particular art area depending on factors such as workload and resources available to complete such workload. The commissioner (Director) has the authority to cause an examination of the application. 35 USC § 131. The Director delegates this authority to a primary examiner to act on behalf of the Director in all "normal" aspects of the examination processes. Applicant has no right to pick and choose the examiner assigned to a particular application as this would cause undue burden upon the agency. Applicant has two avenues of relief when disagreeing with the examiner. 1.) The remedy for improper rejection is appeal to the BPAI (37 CFR § 1.191(a)) and 2.) The remedy for other improper examiner actions is petition (37 CFR § 1.181(a)). These are adequate remedies to address petitioner's concerns related. There is no evidence on record of any

obfuscation by the examiner or delay caused by the examiner. Certainly there is no indication of willful or wanton misconduct against applicants.

#### SUMMARY

The petition pursuant to 37 CFR § 1.144 (treated as a request for reconsideration) is **GRANTED**.

The petition against reintroduction of a rejection reversed by the BPAI is **GRANTED**.

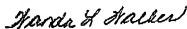
The petition to have the application treated as special is **DISMISSED**.

The petition to have the application transferred is **DENIED**.

#### CONCLUSION

The final Office action mailed January 13, 2010 is **VACATED**. The application file will be forwarded to the examiner for appropriate action in due course.

Any request for reconsideration of this decision must be filed within TWO MONTHS from the mailing date. Extensions of time under 37 CFR § 1.136(a) are not permitted.



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Communications